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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,797	07/22/2003	Joe Lacko	D7260-27	5293
28221 7590 03/31/2008 PATENT DOCKET ADMINISTRATOR LOWENSTEIN SANDLER PC 65 LIVINGSTON AVENUE ROSELAND, NJ 07068				
EXAMINER				
SEREBOFF, NEAL				
ART UNIT		PAPER NUMBER		
3626				
MAIL DATE		DELIVERY MODE		
03/31/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/623,797

Applicant(s)

LACKO, JOE

Examiner

NEAL R. SEREBOFF

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 9-30 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-6 and 9-30 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Response to Amendment/ Notice to Applicant

1. In the amendment dated 1/3/2008, the following has occurred: Claims 1 – 6, 9 – 13 and 16 – 27 have been amended; Claims 7 and 8 have been canceled; Claims 28 – 30 have been added. Claims 1 – 6 and 9 – 30 are pending.
2. The amendment filed 1/3/2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Having a scanner that also transmits data as described in claims 5 and 6. Enabling the kiosk to receive an original prescription as described in claim 26.

Applicant is required to cancel the new matter in the reply to this Office Action.

Priority

3. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:
4. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35

U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/ 397,604, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application.

- A separate payment scanner is not disclosed within the provisional application. Accordingly, claims 2, 21 and 22 are not entitled to the benefit of the prior application.
- The document scanner is not disclosed to also transmit the scanned data. Accordingly, claims 5 and 6 are not entitled to the benefit of the prior application.
- There is no method or system of receiving an original prescription. Accordingly, claim 26 is not entitled to the benefit of the prior application.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 5 and 6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. A scanner that also transmits data was added. The Examiner understands that a separate device transmits the scanned information.

7. Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Receiving the original prescription at the kiosk was added. The originally filed specification describes receiving the originally filed prescription at the delivery location (paragraphs 10, 25 and original claim 26). The Examiner understands that the original prescription is received at another location.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. ***Claim 1 – 27*** are rejected by 35 U.S.C. 102(e) as being anticipated by Hart et al., U.S.

Patent Number 7,006,893.

10. As per claim 1, Hart teaches a system for providing pharmacy services to a customer at a location where a live pharmacist is not available, said system comprising:

- An interactive pharmacy kiosk computer system (column 17, lines 1 – 30) having a videoconference arrangement (column 61, lines 4 – 19), a document scanner (figure 9A1, Fax where a fax machine includes a scanner as evidenced by “What is a fax machine”) and communication system (Figure 9A(1) or Figure 9A(2), Comm or modem); and

- A servicing pharmacy computer system remotely located from the pharmacy kiosk computer system, the servicing pharmacy computer system having videoconference arrangement and a communication system (column 24, lines 34 – 39 and column 61, lines 55 – 67);
 - Wherein the pharmacy kiosk computer system and the servicing pharmacy computer system are interconnected via their respective communication systems in a manner that enables a pharmacy service videoconference to be established between a customer located at the pharmacy kiosk computer system and a live pharmacist located at the servicing pharmacy computer system (column 61, lines 55 – 67);
 - Wherein the servicing pharmacy computer system is activated and enabled to provide pharmacy services when the customer interacts with the pharmacy kiosk computer system (The Examiner interprets “activated” in light of provisional application 60/397,604, “brief description of the invention- a videoconferencing request is initiated”. column 4, lines 5 – 23);
 - Wherein the document scanner enables information relating to pharmacy services to be scanned on the document scanner and transmitted to the servicing pharmacy computer system (column 20, lines 24 – 37 or column 22, lines 30 – 45); and
 - Wherein the servicing pharmacy computer system is configured to receive information scanned on the document scanner and to process the received information to provide pharmacy services requested by the customer (column 25, lines 17 – 38).
11. As per claim 2, Hart teaches the system of claim 1 as described above. Hart further teaches the system wherein the pharmacy kiosk computer system further comprises a payment

scanner to enable payment information to be transmitted from the pharmacy kiosk computer system to the servicing pharmacy computer system (column 3, lines 19 – 27).

12. As per claim 3, Hart teaches the system of claim 1 as described above. Hart further teaches the system wherein the pharmacy kiosk computer system is located in a store (column 2, lines 8 - 23) having a pharmacy, and wherein the pharmacy kiosk computer system is operable when the store is open for business but the pharmacy located in the store is closed (The Examiner interprets the specific location as non-functional descriptive information and therefore has no patentable weight).

13. As per claim 4, Hart teaches the system of claim 3 as described above. Hart further teaches the system wherein the servicing pharmacy computer system is located at a pharmacy and is operable by a pharmacist working at the pharmacy (column 2, lines 8 – 23).

14. As per claim 5, Hart teaches the system of claim 1 as described above. Hart further teaches the system wherein the document scanner is configured for scanning a prescription and transmitting corresponding prescription information to the servicing pharmacy computer system (column 20, lines 24 – 37 or column 22, lines 30 – 45).

15. As per claim 6, Hart teaches the system of claim 5 as described above. Hart further teaches the system wherein the document scanner is configured for scanning identification information and insurance information and transmitting the corresponding information to the servicing pharmacy computer system (column 22, lines 30 – 45 where the information following “configured to” is considered the intended use and therefore has no patentable weight).

16. As per claim 9, Hart teaches the system of claim 1 as described above. Hart further teaches the system wherein the pharmacy kiosk computer system further comprises a handset

having a speaker in an ear piece portion and a microphone in a mouth piece portion for enabling private communications with the live pharmacist at the servicing pharmacy computer system (Figure 9A(1) Fax, where the intended use portion following “enabling” is not patentable. The Examiner assumes that the provisional application figure 1 handset is the standard variety with a microphone and a speaker.).

17. As per claim 10, Hart teaches the system of claim 1 as described above. Hart further teaches the system wherein the videoconference arrangement of both the pharmacy kiosk computer system and the servicing pharmacy computer system comprises a camera, a speaker and a microphone (column 46, lines 55 – 67 and figures 9A(1) and 9A(2)).

18. As per claim 11, Hart teaches the system of claim 1 as described above. Hart further teaches the system wherein the pharmacy kiosk computer system further comprises a touch screen display (figure 7) to permit activation and interaction with the pharmacy kiosk computer system and activate and enable the servicing pharmacy computer system for providing requested pharmacy services (The intended use of the touch screen display does not add patentable weight).

19. As per claim 12, Hart teaches the system of claim 1 as described above. Hart further teaches the system wherein the servicing pharmacy computer system is notified and the live pharmacist is alerted when the customer at the pharmacy kiosk computer system is requesting pharmacy services (column 14, lines 22 – 28 for a controller, or column 54, lines 3 – 12 where the pharmacist is contacted for assistance and assistance is a pharmacy service).

20. As per claim 10, Hart teaches the system of claim 1 as described above. Hart further teaches the system wherein the pharmacy kiosk computer system further comprises a motion

sensor (column 42, lines 10 – 37 where the function of the motion sensor is considered intended use and therefore not given patentable weight) that activates an attract mode on the pharmacy kiosk computer system when a potential customer is within a predetermined distance from the pharmacy kiosk computer system (The Examiner notes that the “attract mode” functionality is not performed but only potentially performed).

21. As per claim 14, Hart teaches the system of claim 1 as described above. Hart further teaches the system wherein the pharmacy kiosk computer system and the servicing pharmacy computer system are interconnected via their respective communication systems using a high-speed telephone connection (column 60, lines 3 – 37 where the connection could be through the Internet or wide area network as further shown in Figure 4B).

22. As per claim 15, Hart teaches the system of claim 1 as described above. Hart further teaches the system wherein the pharmacy kiosk computer system and the servicing pharmacy computer system are interconnected via their respective communication systems using the Internet (Figure 4B).

23. As per claim 16, Hart teaches the system of claim 1 as described above. Hart further teaches the system further comprising a plurality of pharmacy kiosk computer systems at remote locations (Figure 4A, #324), wherein each of plurality of pharmacy kiosk computer systems are interconnected with least one servicing pharmacy computer system (Figure 4A, #320), thereby enabling at the at least one servicing pharmacy computer system to service customers at the various remote locations (Figure 4A, #344).

24. As per claim 17, Hart teaches a method of providing pharmacy services to a customer at a location where a live pharmacist is not available, said method comprising the steps of:

- Providing an interactive pharmacy kiosk computer system at a first location for use by the customer needing pharmacy services (Figure 4A, #340 and #324);
- Providing a servicing pharmacy computer system for use by a pharmacist at a second location remote from the first location (Figure 4A, #344);
- Activating the servicing pharmacy computer system and enabling pharmacy services provided by the servicing pharmacy computer system when the customer interacts with the pharmacy kiosk computer system (The Examiner interprets “activated” in light of provisional application 60/397,604, “brief description of the invention- a videoconferencing request is initiated”. column 4, lines 5 – 23);
- Establishing a pharmacy services videoconference between the customer at the pharmacy kiosk computer system and the pharmacist at the servicing pharmacy computer system (column 61, lines 3 – 19 or column 65, lines 23 – 67);
- Transmitting information relating to pharmacy services from the pharmacy kiosk computer system to the servicing pharmacy computer system in order to enable the pharmacist to service the customer (column 25, lines 17 – 38 or column 65, lines 23 – 67); and
- Processing information relating to pharmacy services to provide pharmacy services requested by the customer (column 66, lines 15 – 34 where the drug is dispensed).

25. As per claim 18, Hart teaches the method of claim 17 as described above. Hart further teaches the method wherein information transmitted from the pharmacy kiosk computer system to the servicing pharmacy computer system includes prescription information associated with the customer requesting pharmacy services (column 66, lines 15 – 34).

26. As per claim 19, Hart teaches the method of claim 18 as described above. Hart further teaches the method wherein information transmitted from the pharmacy kiosk computer system to the servicing pharmacy computer system further includes identification information associated with the customer requesting pharmacy services (column 14, lines 28 - 39 where the patient is identified by their card.).

27. As per claim 20, Hart teaches the method of claim 19 as described above. Hart further teaches the method wherein information transmitted from the pharmacy kiosk computer system to the servicing pharmacy computer system further includes insurance information associated with the custom requesting pharmacy services (column 17, lines 45 - 67 where the insurance information is verified. The Examiner notes that the Insurance information is non-functional as it is only passed between the two devices.)

28. As per claim 21, Hart teaches the method of claim 19 as described above. Hart further teaches the method wherein information transmitted from the pharmacy kiosk computer system to the servicing pharmacy computer system further includes payment information associated with the customer requesting pharmacy services (column 3, lines 19 - 27).

29. As per claim 22, Hart teaches the method of claim 17 as described above. Hart further teaches the method wherein information transmitted from the pharmacy kiosk computer system to the servicing pharmacy computer system includes at least one of prescription Information, identification information, insurance information and payment information associated with the customer requesting pharmacy services (column 14, lines 28 - 39, identification information).

30. As per claim 23, Hart teaches the method of claim 22 as described above. Hart further teaches the method further comprising filling or receiving prescription delivery instructions from the customer requesting pharmacy services (Abstract, where the prescriptions are filled).

31. As per claim 24, Hart teaches the method of claim 23 as described above. Hart further teaches the method comprising filling or refilling a prescription based on information received by the servicing pharmacy computer system from the pharmacy kiosk computer system (Abstract, where the prescriptions are filled).

32. As per claim 25, Hart teaches the method of claim 24 as described above. Hart further teaches the method comprising delivering the filled or refilled prescription in accordance with delivery instructions received from the pharmacy kiosk computer system (column 30, lines 46 - 53).

33. As per claim 26, Hart teaches the method of claim 24 as described above. Hart further teaches the method comprising receiving an original prescription at the pharmacy kiosk computer system upon confirmation of a filled prescription to satisfy pharmacy services requirements adopted by the servicing adopted by the servicing pharmacy computer system (column 13, lines 32 – 40 where the kiosk is at the physician's office that writes the prescription or column 16, lines 61 - 67).

34. As per claim 27, Hart teaches the method of claim 17 as described above. Hart further teaches the method comprising providing a plurality of pharmacy kiosk computer systems at various remote locations (Figure 4A, #324), wherein each of the plural of pharmacy kiosk computer systems is configured for establishing a videoconference session with at least one

servicing pharmacy computer system (Figure 4A, #320 where the configure is shown in Figure 9A).

35. As per claim 28, Hart teaches a method of providing pharmacy services to a customer at a location where a live pharmacist is not available, said method comprising the steps of:

- Detecting customer interaction with a pharmacy kiosk computer system (column 4, lines 5 – 23);
- Receiving a customer interaction signal at a servicing pharmacy computer system located remotely from the pharmacy kiosk computer system (column 4, lines 24 - 40 where the computers are interconnected and communicate);
- Activating the servicing pharmacy computer system when the customer interaction signal is transmitted to the servicing pharmacy computer system, enabling the servicing pharmacy computer system to provide requested pharmacy services (The Examiner notes that this step is not positively recited in that activating the computer means that it could be turned on, or moved from one state to another and second that enabling the computer does not mean that anything is actually performed just potentially performed. Column 4, lines 24 – 40 where the controlling information is determined);
- Establishing videoconference session between the customer located at the pharmacy kiosk computer system and a live pharmacist located at the servicing pharmacy computer system (column 61, lines 3 – 19 or column 65, lines 23 – 67);
- Receiving and transmitting information related to pharmacy services from the pharmacy kiosk computer system (column 25, lines 17 – 38 or column 65, lines 23 – 67);

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- Processing information related to pharmacy services at the servicing pharmacy computer system (column 66, lines 15 – 34 where the drug is dispensed).

36. As per claim 29, Hart teaches a system for providing pharmacy services to a customer at a location where a live pharmacist is not available, said system comprising:

- A pharmacy kiosk computer system (column 17, lines 1 – 30) including a videoconference arrangement (column 61, lines 4 – 19), a document scanner (figure 9A1, Fax where a fax machine includes a scanner as evidenced by “What is a fax machine”) and communication system (Figure 9A(1) or Figure 9A(2), Comm or modem); and
- A servicing pharmacy computer system remotely located from the pharmacy kiosk computer system, the servicing pharmacy computer system including a videoconference arrangement and a communication system (column 24, lines 34 – 39 and column 61, lines 55 – 67);
- Wherein the pharmacy kiosk computer system and the servicing pharmacy computer system are interconnected via their respective communication systems in a manner that enables a pharmacy service videoconference to be established between a customer located at the pharmacy kiosk computer system and a live pharmacist at the servicing pharmacy computer system (column 61, lines 55 – 67);
- Wherein information related to a prescription is scanned on the document scanner of the pharmacy kiosk computer system and transmitted to the servicing pharmacy computer system (column 20, lines 24 – 37 or column 22, lines 30 – 45); and
- Wherein the servicing pharmacy computer system is configured to fill the prescription (column 25, lines 17 – 38).

37. As per claim 30, Hart teaches a method of providing pharmacy services to a customer at a location where a live pharmacist is not available, said method comprising the steps of:

- Providing a pharmacy kiosk computer system at a first location for use by the customer needing pharmacy services (Figure 4A, #340 and #324);;
- Providing a servicing pharmacy computer system for use by a pharmacist at a second location remote from the first location (Figure 4A, #344);
- Establishing a pharmacy services videoconference between the customer at the pharmacy kiosk computer system and the pharmacist at the servicing pharmacy computer system (column 61, lines 3 – 19 or column 65, lines 23 – 67);
- Providing information related to a prescription from the customer to the pharmacist in order to enable the pharmacist to service the customer (column 25, lines 17 – 38 or column 65, lines 23 – 67); and
- Filling the customer (column 66, lines 15 – 34 where the drug is dispensed).

The Examiner notes that nothing is performed in the providing step. The act of providing may mean that a system is available for potential use. The system may be in pieces and not functional but still available.

The establishing step and the providing step do not require the computers made available at the initial providing steps but could use another network not described.

Response to Arguments

38. Applicant's arguments with respect to claims 1 – 27 have been considered but are moot in view of the new ground(s) of rejection.

The Applicant admits in the 1/3/2008 arguments that, “The novelty presented in Applicant’s claimed invention, however, is not the use of these individual computer components, but rather how the combination of these components are arranged and configured to provide a means for addressing a desired need in the pharmacy services realm.” The Examiner notes that any future amendments should be taken in light of the Applicant’s admission and the recent U.S. Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* published in the Federal Register, Vol. 72, No. 195, pages 57526-57535.

Specifically:

- The prior art teaches a base device (or method, product) similar or analogous to the claims.
- Design incentives or market forces would have prompted change to the base device.
- Known variations or principles would meet the difference between the claimed invention and the prior art and the implementation would have been predictable.

OR

- The elements are all known but not combined as claimed.
- The technical ability exists to combine the elements as claimed and the results of the combination are predictable.
- When combined, the elements perform the same function as they did separately.

Conclusion

39. The prior art made of record and not relied upon is considered pertinent to applicant’s disclosure.

Diebold, "Drive-Thru Kiosks"

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEAL R. SEREBOFF whose telephone number is (571)270-1373. The examiner can normally be reached on Mon thru Thur from 7:30am to 5pm, with 1st Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Luke Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. R. S./
Examiner, Art Unit 3626
3/18/2008

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626